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REMARKS

1. Status of the Claims

Claims 1-6, 9-16, 19-32 and 39 are pending in the above-identified patent application. Claims 1, 2, 14 and 39 are amended herein. Claims 7 and 8 are canceled by this Amendment. No new matter is introduced.

2. Rejections Under 35 USC § 112, First Paragraph

Claims 1-15, 32 and 39 were rejected under 35 USC § 112, first paragraph for failure to comply with the written description requirement. The Examiner stated that no support in the specification or originally filed claims can be found for recitation of "cycloalkylakeny" with respect to the variable R³. Claims 1 and 2 have been amended to delete the recitation "cycloalkylakeny". Claims 1 and 2 as amended, as well as claims 3-15 and 32 which depend either directly or indirectly from claims 1 and 2, are believed by Applicants to meet the requirements of 35 USC § 112, first paragraph. Independent claim 39 does not include any recitation of "cycloalkylakeny", and Applicants respectfully believe that claim 39 in its current form meets the criteria of 35 USC § 112, first paragraph.

3. Rejections Under 35 USC § 112, Second Paragraph

The Examiner rejected claims 7, 8 and 14 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Examiner indicated that claims 7 and 8 lack antecedent basis for the recitation of "optionally substituted heteroaryl" with regard to variable R³. Applicants have canceled claims 7 and 8. The Examiner also pointed out that claim 14 does not end with a period and thus does not conform to MPEP § 608.01. Applicants have amended claim 14 to include a period at the end thereof.

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4. Rejection of Claims Under the Judicially Created Doctrine of Obvious Type Double Patenting

Claims 1-6, 16, 28, 32 and 39 were rejected under the judicially created doctrine of obvious type double patenting over US 6,376,527. US 6,376,527 issued from U.S. Application Ser. No. 09/305,707, which is the parent application for the above-identified patent application, and is commonly owned by Roche Palo Alto LLC (formerly "Syntex USA LLC").

A terminal disclaimer in accordance with 37 CFR §1.321(c), disclaiming the patent term beyond that US 6,376,527, is submitted herewith.

6. Other Claim Amendments

The Applicants have corrected informalities in claims 1 and 39. Claim 1 has been amended to correct the lettering (numbering) of the Markush elements recited for the variable R³. This amendment corrects an inconsistency in the lettering resulting from Applicants' previous deletion of element "(b)" in the Amendment mailed on April 07, 2004. Claim 39 has been amended to correctly locate the word "or" in Markush element "(f)" of the variable R³.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-354-7540.

Please charge the fee for a Terminal Disclaimer (37 CFR §1.20(d)) to Applicants' deposit account No. 18-1700.

Respectfully submitted,



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